

REMARKS

Upon entry of this amendment, claims 1, 2, 4-15, 17, 18 and 23-27 will be active, claim 22 having been canceled and incorporated into claim 1.

Undersigned counsel thanks Examiner Yu and Primary Examiner Padmanabhan for an interview on April 23, 2003, summarized below. Favorable reconsideration is requested.

As amended, the claims relate to a composition for treating skin or mucosal disorders consisting of beeswax and a specific combination of oils, i.e., olive oil, sunflower oil, almond oil, cod liver oil, and castor oil, along with added vitamins and a pharmaceutically acceptable excipient and preservative. The applicants have found that this combination is highly effective for treating burns and promoting healing while imparting a relatively non-greasy feeling to the treated area.

Claims 4-15, 17, 18, 22-24 and 26 are rejected under 35 USC 112, second paragraph as being indefinite.

The claims have been amended to address issues raised by the examiner. The main claims recite the presence of at least one added vitamin, and so the dependent claims which recite vitamins are clearly within the scope of claim 1. Likewise, with regard to the excipients, claims 17 and 18 are both within the scope of claim 1. Claim 1 also now recites the presence of a preservative, and claim 23 specifies a particular preservative, butylhydroxytoluene.

Claims 4-15, 17, 18, 22-27 are rejected as being incomplete for depending on claim 3, which had been canceled previously. Accordingly, the dependent claims have been amended to depend from claim 1.

Claims 1, 2, 4-15, 17, 22 and 24-27 are rejected under 35 USC 103(a) over Slimak in view of Soto, Kaplan and George.

Slimak teaches a composition comprising beeswax and oil for the treatment of skin. While several oils are mentioned as possible ingredients, the Examiner concedes that the reference fails to describe castor oil and cod liver oil, and fails to provide any motivation to select the particular combination of oils recited in the present claims. (Official Action page 4, last paragraph). The examiner also noted that Slimak, Soto and Kaplan fail to suggest combining castor oil, cod liver oil and vitamins A or D with the beeswax composition in Slimak. (Official Action page 5, third paragraph).

George discloses a medicinal preparation for skin, based on a combination of cod liver oil and castor oil only. The fish oil is said to act as a vehicle for the castor oil (Column 2, lines 24-26). The castor oil is said to prevent the growth of scar tissue, and the fish oil controls the caustic action of the castor oil, while at the same time promoting the healing of the wound. (Column 2, lines 43-48). However, the components of the present invention corresponding to a "vehicle" are beeswax and a pharmaceutically acceptable excipient, such as liquid petroleum jelly and stearic acid. Therefore, a person of skill in the art would not need the cod liver oil of George as a vehicle. Nor would there be any reason to modify the composition of George by adding beeswax (or any of the other oils recited in the claims, i.e., olive oil, sunflower oil and almond oil,) since cod liver oil is already serving the vehicle function. Accordingly, a person of skill in the art would not have been motivated to combine the references to arrive at the specific combination of beeswax and five distinct oils plus an excipient, as claimed.

It is well settled that the disclosure of one reference can only be combined with the disclosure of an additional reference if the requisite motivation for the combination can be found in the references. As stated by the Federal Circuit:

In proceedings before the Patent and Trademark Office, the examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art... "[the examiner] can satisfy this burden only by showing some objective teaching in the prior art with the knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevance teachings of the references." *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (FED. CIR. 1988).

In re Fritch, 23 USPQ 2d 1780, 1783 (FED. CIR. 1992). It is also well-settled that a prima facie case of obviousness can not be predicated on hindsight reconstruction.

As stated by the board:

In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known.

The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references... . Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide.

It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.
Ex Parte Clapp, 227 USPQ 2 972, 973 (BPAI 1985).

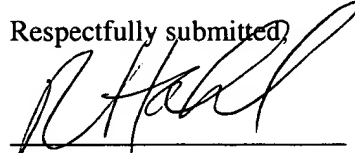
Similarly, the Federal Circuit has stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (Quoting *In re Fine*, 837F. 2d 1071, 1075, 5 USPQ 2(d) 1596, 1600 (FED. CIR. 1988).

In the present case, the examiner admits that neither George or the combination of Slimak, Soto and Kaplan teach compositions containing all of the claimed components, and merely show that all of those components are well known and commonly used in the art. But in combining those component as required by the claims, one can see that certain functions such as the carrier or "vehicle" of George are duplicated by other components in the combined product which came from Slimak, Kaplan or Soto. A person of skill in the art would not naturally seek to use all those ingredients, because some are merely serving the same function as different ingredients in the hypothetical composition of the combined references. In addition, one could not have predicted the excellent, non-greasy feeling of the claimed combination from the cited references.

Accordingly, the claimed mixture consisting of five specific oils and beeswax plus excipient would not have been obvious within the meaning of 35 USC 103(a).

Respectfully submitted,



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